

Serial No. 09/595,039
Attorney Docket No. E0902
Firm Reference No. AMDSP0379US

Reply to Office Action Dated May 18, 2004
Reply Dated July 20, 2004

REMARKS

Following entry of the above amendment, claims 1-28 will be pending. Claim 1 has been amended to clarify the features of the network medium interface card. Claim 23 has been amended to correct an obvious typographical error without change in scope, i.e., a forward slash (/) has been inserted between the words "and" and "or" in line 2 of the claim. Claim 24 has been amended to correct an obvious grammatical error without change in scope. It is believed that the amendments contained herein raise no new issues, do not require an additional search and place the application in a better condition for allowance and/or appeal. Accordingly, entry of the amendment is considered proper.

I. REJECTION OF CLAIMS UNDER 35 U.S.C. § 102

Lidinsky

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Lidinsky et al., U.S. Patent No. 4,897,874 ("Lidinsky"). Withdrawal of the rejection is respectfully requested for at least the following reasons.

The Examiner maintains the reasons set forth in the previous Office Action paper number 5, paragraph 4 mailed January 28, 2004. Additionally, the Examiner asserts Lindinsky teaches or suggests "a network medium interface card". The Applicants respectfully disagree with these assertions for the following reasons.

Although a network medium interface card is not specifically disclosed by Lidinsky, the Applicants agree that a network medium interface card could be used in the disclosed network connectivity environment, i.e., a high-capacity metropolitan area network (MAN) to connect the a network interface module (NIM) 2 to an end user system (EUS) 26, a workstation 4, a file server 6 or an ETHERNET 8. Abstract; Col. 6, lines 3-56; FIG. 2 (FIG. 2 is provided below for the Examiner's convenience.) However, contrary to the Examiner's assertions, the disclosure of the above-identified individual components by Lindinsky does not clearly demonstrate a network medium interface card as recited in amended claim 1. That is, Lidinsky does not disclose a

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network medium interface card that includes first and second blocks, an external interface and a switchable connection.

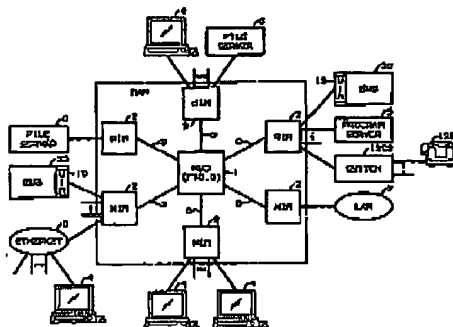


FIG. 2

Claim 1 as amended includes, *inter alia*, a network medium interface card that includes first and second blocks, an external interface and a switchable connection. The switchable connection may be selectively configured either to internally connect the blocks to each other, or one of the blocks to a transmit portion and/or a receive portion of the external interface. (FIG. 3 is provided below for the Examiner's convenience.)

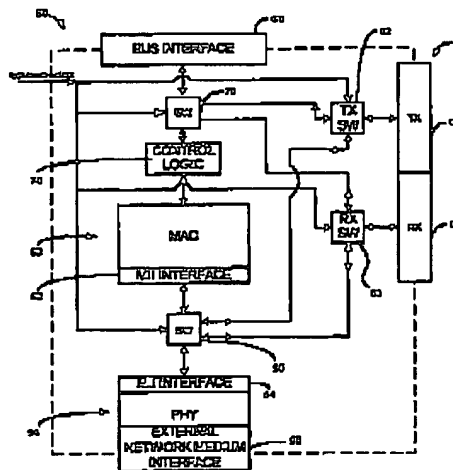


FIG. 3

In contrast, Lidinsky discloses a MAN including the above-identified components that covers an area larger than a city. Additionally, Lidinsky discloses the external links have an intended length "on the order of 10s of kilometers". Col. 10, lines 20-22. Thus, the Examiner could not reasonable maintain a city size set of components could be included on a network

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medium interface card. Since Lidinsky does not teach or suggest the network medium interface card as recited in amended claim 1, amended claim 1 is patentable over Lidinsky.

Hutchison

Claims 1, 4-7, 10-16 and 18-21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hutchison et al., U.S. Patent No. 5,838,989 ("Hutchison"). Withdrawal of the rejection is respectfully requested for at least the following reasons.

Hutchison discloses a switch 56 for selectively coupling to two connectors (50 and 52). Col. 5, line 57 - col. 6, line 1; FIG. 3 (FIG. 3 is provided below for the Examiner's convenience.) The switch 56 is used to select which connector/MAU combination is utilized. Col. 6, lines 5-29. Hutchison does not disclose use of the switch 56 for connecting the two connector/MAU combinations to each other for passing data between the two connector/MAU combinations. In contrast, data passes between block 52 and block 54 and between block 66 and block 52. See, for example, FIG. 3 and specification page 5, lines 4-7.

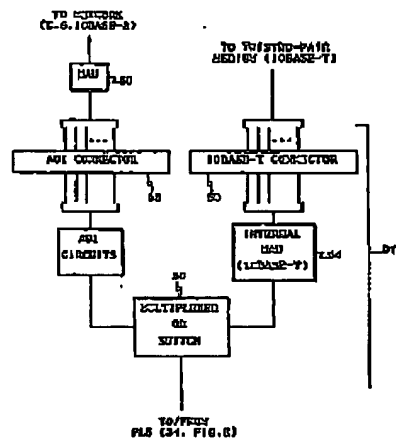


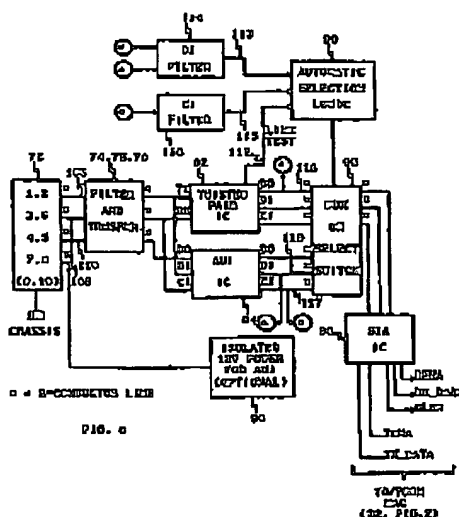
FIG. 3 (PRIOR ART)

In another embodiment, Hutchison discloses a single interface connector that includes interface chips 92 and 94. Col. 10, lines 55-56; Fig. 6 (FIG. 6 is provided below for the Examiner's convenience.) The chips 92 and 94 are coupled to a selector switch 96. Col. 11, lines 4-18. As the Examiner points out, a single VLSI chip to implement the functions for AUI and 10BASE-T including items 92, 94 and 96 may be used. However, contrary to the Examiner's assertion, the function of the selector switch 96 is to select one set of signals, either those

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connected to the interface chip 92 or those connected to the interface chip 94. Col. 11, lines 9-12. Thus, Hutchison does not disclose using the selector switch 96 to connect the interface chips 92 and 94 to each other for passing data between the interface chips 92 and 94. Again in contrast, data passes between block 52 and block 54 and between block 66 and block 52. See, for example, FIG. 3 and specification page 5, lines 4-7.



Since Hutchison does not teach or suggest all of the limitations of amended claim 1, claims 1, 4-7, 10-16, and 18-21 are patentable over Hutchison.

In addition, some of the dependent claims recite additional features not taught or suggested by Hutchison. Hutchison, at least in the portions relied upon in the Action, does not teach or suggest the second switchable connection recited in claim 6. The embodiments of Hutchison relied upon each involve a single switch, in contrast to the multi-switch configurations disclosed in the present application, see, e.g., the embodiment of Fig. 3, which has switchable connections 56, 76, 82, and 86. Therefore for additional reasons, claims 4-7, 10, and 11 are patentable over Hutchison.

Claim 12 recites a method of testing operation of an internal block (e.g., blocks 52, 54 and 56) of a network medium interface device (50), the method including, *inter alia*, reconfiguring the interface device 50 such that a normally-internally-connected connection

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(e.g., block 52 to block 54 and block 66 to block 52) of the block is connected to an external interface (70). See, for example, FIGs. 3-9.

The portions of Hutchison relied upon make no mention of a testing operation, e.g., testing the performance of an internal block of a device. Further, Hutchison does not teach or suggest reconfiguring the interface such that a normally-internally-connected connection (FIG. 3, block 52 to block 54 or block 66 to block 52) of the block is connected to an external interface. Instead, Hutchison discloses using a switch to select one connector/MAU combination or one interface chip. Nothing in the portions of Hutchison relied upon teaches or suggests the recited reconfiguring so as to make such that a normally-internally-connected connection of the block is connected to an external interface. Since Hutchison does not teach or suggest all of the recited features of claim 12, claims 12-16 and 18-21 are patentable over Hutchison.

II. REJECTION OF CLAIMS UNDER 35 USC §103(a)

Combination of Hutchison and Jeng

Claims 2-3, 8-9 and 17 stand rejected under 35 U.S.C. § 103(a) as obvious over Hutchison in view of Jeng, U.S. Patent No. 5,892,768 ("Jeng"). Withdrawal of the rejection is respectfully requested for at least the following reasons.

Jeng does not make up for the failure of Hutchison to teach or suggest all of the recited features of claims 1 and 12, as discussed above. Therefore claims 2, 3, 8, 9, and 17 are patentable over Hutchison and Jeng, either alone or in combination.

Claims 22-28

Claims 22-28 stand rejected under the same rationale applied to claims 1-11. Withdrawal of the rejection is respectfully requested for at least the following reasons.

The Examiner asserts that claim 22 merely recites the minor difference of including a MAC and a PHY limitation covered by claim 1 and claims 4 and 5. However, claim 22 is patentable over either Lindinsky or Hutchison. However, neither Lindinsky nor Hutchison disclose a switchable connection wherein the switchable connection may be selectively configured either to internally connect the MAC to the PHY, or to connect either the MAC or

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the PHY to a transmit portion and/or a receive portion of the external interface, as discussed above with regard to amended claim 1. Since neither Lindinsky nor Hutchison teach or suggest all of the features of claim 22, claim 22 is patentable over either Lindinsky or Hutchison.

Further, the dependent claims recite additional features not taught or suggested by Lindinsky or Hutchison. That is, neither Lindinsky nor Hutchison disclose configuring the switchable connection to test operation of the MAC and/or the PHY as recited in claim 23. Neither Lindinsky nor Hutchison disclose a second switchable connection nor a second switchable connection configurable to test the operation of a MAC and/or a third block as recited in claim 24. Further still, neither Lindinsky nor Hutchison teach or suggest first and second switches may be configured to test operation of an additional MAC, an additional PHY or a third block as recited in claims 26, 27 and 28, respectively. Therefore, claims 23-28 are patentable over Lindinsky or Hutchison for at least these additional reasons.

III. CONCLUSION

In light of the foregoing, it is respectfully submitted that the present application is in condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present invention.

Any additional fee(s) resulting from this communication is hereby authorized to be charged to our Deposit Account No. 18-0988; Our Order No. E0902 (AMDSP0379US).

Respectfully submitted,
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